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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/627,805 | 07/28/2003 | Makoto Nagao | Q76090 | 4338 |

7590 09/27/2005

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| EXAMINER |
|---|
| BERNATZ, KEVIN M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1773 | |

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/627,805 | NAGAO ET AL. | |
| | Examiner | Art Unit | |
| | Kevin M. Bernatz | 1773 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/717,342.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1. Amendments to claims 10, 15 and 27, filed on September 6, 2005, have been entered in the above-identified application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Examiner's Comments*

3. Upon reconsideration and partly in view of the deficiencies of the Office Action mailed October 19, 2004, the finality of the rejection of April 4, 2005 is withdrawn and prosecution reopened. The Examiner apologizes for the inconvenience caused by the necessity of the reopening of prosecution.

An office action on the merits follows below:

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 10 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As admitted by applicants, the as-filed specification "did not list weight ratio or atomic ratio" (*page 9 of response filed September 6, 2005*). The Examiner notes that both weight ratios and atomic ratios are commonly used in the art and the specification does not provide enablement for which of the two is intended.

***Claim Rejections - 35 USC § 102***

6. Claims 1, 2, 8, 19 – 21, 23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawazaki (U.S. Patent No. 4,422,106) as evidenced by Oda et al. (U.S. Patent No. 5,435,903) for the reasons of record as set forth in Paragraph 5 of the Office Action mailed April 4, 2005.

7. Claims 1 – 9, 18 – 26 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida et al. (WO98/03972) as evidenced by Oda et al. ('903) for the reasons of record as set forth in Paragraph 6 of the Office Action mailed April 4, 2005.

***Claim Rejections - 35 USC § 103***

8. Claims 1 – 9, 18 – 26 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. (WO '972) in view of Oda et al. ('903) and Sawazaki ('106) for the reasons of record as set forth in Paragraph 7 of the Office Action mailed April 4, 2005.

9. Claims 10 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. as applied above in Paragraph 7, and further in view of Takahashi et al. (U.S. Patent No. 5,173,370) for the reasons of record as set forth in Paragraph 8 of the Office Action mailed April 4, 2005.

The Examiner notes that the rejection of record refers to atomic percents of the alloys, hence still reading on the claimed limitations (*"Takahashi teaches ... below certain Co contents (~30 at% Co)" – Paragraph 45 of the Office Action mailed on October 19, 2004*).

10. Claims 10 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. in view of Oda et al. and Sawazaki as applied above in Paragraph 8, and further in view of Takahashi et al. ('370) for the reasons of record as set forth in Paragraph 9 of the Office Action mailed April 4, 2005.

The Examiner notes that the rejection of record refers to atomic percents of the alloys, hence still reading on the claimed limitations.

11. Claims 16, 17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. as applied above in Paragraph 7, and further in view of Nishimatsu et al. (U.S. Patent No. 4,701,375) for the reasons of record as set forth in Paragraph 10 of the Office Action mailed April 4, 2005.

12. Claims 16, 17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. in view of Oda et al. and Sawazaki as applied above in Paragraph 8, and further in view of Nishimatsu et al. ('375) for the reasons of record as set forth in Paragraph 11 of the Office Action mailed April 4, 2005.

13. Claims 11 – 15 and 28 - 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. as applied above in Paragraph 7, and further in view of Kitaori et al. (U.S. Patent No. 5,796,533) and Dearnaley et al. (U.S. Patent No. 5,922,415) for the reasons of record as set forth in Paragraph 12 of the Office Action mailed April 4, 2005.

14. Claims 11 – 15 and 28 - 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. in view of Oda et al. and Sawazaki as applied above in Paragraph 8, and further in view of Kitaori et al. ('533) and Dearnaley et al. ('415) for the reasons of record as set forth in Paragraph 13 of the Office Action mailed April 4, 2005.

***Response to Arguments***

**15. The rejection of claims 10 and 27 under 35 U.S.C § 112 – 1st Paragraph**

Applicant(s) argue(s) that the atomic ratio is "the commonly used standard for composition of magnetic substances" (*page 9 of response*). The examiner respectfully disagrees.

The Examiner notes that it is well known to use both "weight ratio" or "atomic ratio" and there is no art recognized standard to only use one or the other for magnetic vs. non-magnetic materials. As such, the Examiner does not find applicants' arguments convincing since while it is certainly possible to use "atomic ratio", it is also possible to use "weight ratio".

**16. The rejection of claims 1, 2, 8, 19 – 21, 23 and 26 under 35 U.S.C § 102(b) – Sawazaki, as evidenced by Oda et al.**

**17. The rejection of claims 1 - 32 under 35 U.S.C § 102(b) and/or 103(a) – Ishida et al., alone or in view of various references**

Applicant(s) repeat the arguments previous presented, that the claimed relative permeability must be the relative permeability as measured in a DC field and that a relative permeability as measured in an AC field cannot read on the claimed invention. The examiner respectfully disagrees for the same reasons as previously argued.

Applicants' argument that the examples at pages 11 – 13 and Tables 1 – 3 would lead one of ordinary skill to conclude that a DC magnetic field *must* have been used is not found persuasive. The Examiner notes that measuring them at a fixed frequency of AC current would still produce meaningful data, in that one would obtain relative values to each other. Unfortunately, applicants' as-filed disclosure does not indicate whether the values reported in Tables 1 – 3 are permeability values measured by applying a DC magnetic field, or in an AC magnetic field with a fixed frequency of measurement. Both cases would lead to substantially identical looking data as presented in Tables 1 – 3.

Applicants further argue that they have found "that poor transfer resulted when relative magnetic permeability of the magnetic layer of the master carrier was high" and that when the "relative permeability is too low, the magnetic field for transfer is not absorbed in the master carrier" (*page 14 of response*). In addition, applicants argue that the "only the transfer by direct current is in question" (*page 15 of response*).

The examiner notes that the specification is not the measure of the invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968). In the instant case, the claims do not recite *when* the relative permeability is measured, they merely recite *a* relative permeability. The fact that the claims specify that the transfer occurs by applying a DC magnetic field is not relevant to when the relative permeability is measured since the claims don't limit the measurement of the relative permeability to the argued language. Again, the claims merely recite *a* relative permeability. Applicants' arguments appear to be directed to a situation where the magnitude of the relative permeability of the magnetic layer is determined during the magnetic transfer, which is *not* currently claimed.

Finally, applicants' point to Sugita et al. (IEEE Trans. Mag. article) which also fails to disclose whether the relative permeability is measured in a DC field or an AC field and argue that since "magnetic transfer is performed by applying a DC magnetic field ... those skilled in the art would understand that it is the relative magnetic permeability in DC" which is measured (*page 15 of response*).

First, the Examiner notes that the fact that another inventive entity fails to properly elucidate their invention does not remove the burden from applicants. Furthermore, a legal document such as a patent is held to a higher standard than a scientific journal article. The claims should be self-contained, clear and precise. The Examiner agrees with applicants that the claim terms are construed in light of the specification, but as stated previously, the specification does not specify how the reported values of magnetic permeability are measured. As such, the specification does not help in defining the limitation "magnetic permeability" and the Examiner maintains that the limitation must be given the broadest reasonable interpretation(s) consistent with the written description in applicants' specification as it would be interpreted by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Donaldson Co., Inc.*, 16 F.3d 1190, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994). See MPEP 2111. Since nothing in applicants' specification makes the measurement of the magnetic permeability under an AC current (with a fixed frequency) inconsistent with the disclosed invention, the Examiner deems that the proper scope afforded to the claimed term is the one presently relied upon in the rejections of record.

While the Examiner wishes to believe applicants, the Examiner must remind applicants that the question is not what the Examiner believes to be correct, but what applicants have literal support for (or overwhelming evidence for an inferred limitation). Given that the as-filed specification does not clearly elucidate which method was used to measure the relative permeability and the fact that, in the art, it is known that the

relative permeability *can* be measured both ways, the Examiner has no choice but to give the claims the broadest reasonable interpretation as noted above.

## *Conclusion*

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicants' amendment resulted in embodiments not previously considered (i.e. "FeCo in an atomic ratio of 70:30 and FeNiMo in an atomic ratio of 75:20:5") which necessitated the new grounds of rejection, and hence the finality of this action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
September 12, 2005

Kevin M. Bernatz, PhD
Primary Examiner